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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/311,753 05/14/99 INQUE

T 054370

EXAMINER

IM52/0620

SUGHRUE, MION, ZINN, MACPEAK & SEAS  
2100 PENNSYLVANIA AVENUE N W  
WASHINGTON DC 20037

BERNATZ, K

ART UNIT

PAPER NUMBER

1773

DATE MAILED:

06/20/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Office Action Summary

Application No.

09/311,753

Applicant(s)

INOUE ET AL.

Examiner

Kevin M Bernatz

Art Unit

1773

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --  
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☐ Responsive to communication(s) filed on \_\_\_\_.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 2-4 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 2-4 is/are rejected.
- 7) ☒ Claim(s) 2 and 3 is/are objected to.
- 8) ☐ Claims \_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_ is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on \_\_\_\_ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

## Priority under 35 U.S.C. § 119

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

## Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) \_\_\_\_.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other:

## **DETAILED ACTION**

### ***Response to Amendment***

1. Preliminary amendments to claims 1 - 4, filed on March 19, 2001, have been entered in the above-identified application.
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.

### ***Specification***

3. The abstract of the disclosure is objected to because it exceeds the current acceptable length. The abstract is now limited to 150 words or 15 lines (37 CFR 1.72). Correction is required. See MPEP § 608.01(b).

### ***Claim Objections***

4. Claims 2 and 3 are objected to because of the following informalities: it is unnecessary to use "of from" when stating a range. Proper grammar only requires "of". Appropriate correction is required.
5. Claim 2 is objected to because of the following informalities: stating that the adhesive layer is formed on "one surface" of the polymer film is confusing since it implies that the adhesive layer could technically be formed between the non-woven fabric and the polymer film. The claim language would be clearer if a positive recitation

Art Unit: 1773

was made that the adhesive layer was formed on the polymer film surface opposed to the polymer film surface adhered to the non-woven fabric.

***Claim Rejections - 35 USC § 102***

6. Claims 2 – 4 are rejected under 35 U.S.C. 102(b) as being anticipated by Groff (U.S. Patent No. 4,308,313).

Regarding claims 2 and 4, the claimed invention reads on Groff as follows: Groff discloses a sheet which comprises a support comprising a thermoplastic polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer formed on one surface of said polymer film, wherein said non-woven fabric has a basis weight of 5 to 100 g/m<sup>2</sup> (col. 1, line 64 bridging col. 2, line 67; col. 4, lines 65 – 67; and Example 3). The limitation “for protecting paint films of automobiles” is an intended use limitation and is not limiting in so far as the structure of the film is concerned.

Regarding claim 3, Groff discloses the <sup>thickness of the</sup> thermoplastic polymer sheet to be within applicants' claimed range (Examples 2 and 3).

***Claim Rejections - 35 USC § 103***

7. Claims 2 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over E. P. Wenzelberger et al. (U.S. Patent No. 2,352,463) in view of Brown et al. (U.S. Patent No. 5,662,978).

Regarding claim 2, E. P. Wenzelberger et al. disclose a sheet which comprises a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer formed on one surface of said polymer film (Figures and col. 2, lines 15 – 27). The limitation “for protecting paint films of automobiles” is an intended use limitation and is not limiting in so far as the structure of the film is concerned.

E.P. Wenzelberger et al. fail to disclose the non-woven fabric having a basis weight of 5 to 100 g/m<sup>2</sup>.

However, Brown et al. teach a protective non-woven fabric and polymer film laminate structure meeting applicants' claimed limitations (col. 6, lines 23 – 51; col. 7, lines 21 – 23; and Example 2) that provides excellent impact resistance and can be used as a protective cover for automobiles (col. 12, lines 12 – 25).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of E. P. Wenzelberger et al. to use a non-woven fabric having a basis weight within applicants' claimed range as taught by Brown et al. in order to produce an adhesive film that provides excellent impact resistance and can be used as a protective cover for automobiles.

Regarding claims 3 and 4, Brown et al. teach thermoplastic resin layers within applicants' claimed thickness range in order to produce films that are lightweight, waterproof and impact resistant (col. 1, lines 5 – 37; col. 8, lines 44 – 61; and Example 2).

Art Unit: 1773

8. Claims 2 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Mamish ('225) in view of Deeb et al. (U.S. Patent No. 6,042,882).

Regarding claims 2 and 4, Mamish disclose a sheet which comprises a support comprising a thermoplastic polymer film laminated on one or both surfaces of a non-woven fabric, and a pressure-sensitive adhesive layer, wherein the non-woven fabric has a basis weight of 5 to 100 g/m<sup>2</sup> (col. 1, lines 35 – 62; col. 2, lines 9 - 38<sup>and example 1</sup>). The limitation “for protecting paint films of automobiles” is an intended use limitation and is not limiting in so far as the structure of the film is concerned.

Mamish fail to disclose the pressure-sensitive adhesive layer being formed on the surface of the polymer film opposed to the non-woven fabric.

However, Deeb et al. teach an adhesive comprising a woven fabric, a thermoplastic film and a pressure-sensitive adhesive, where the polymer film is imposed between the fabric and the pressure-sensitive adhesive in order to prevent the adhesive from striking through the backing of the tape, penetrating the fabric and being contaminated with moisture (col. 3, lines 11 – 25 and col. 7, lines 34 – 47).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Mamish to place the polymer film between the pressure-sensitive adhesive layer and the non-woven fabric layer as taught by Deeb et al. in order to prevent the adhesive from striking through the backing of the tape, penetrating the fabric and being contaminated with moisture.

Regarding claim 3, Mamish disclose thermoplastic films having a thickness within applicants' claimed range (col. 2, lines 35 – 38 and Table 3).

9. Claims 2 – 4 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shirai et al. (either U.S. Patent No. 6,037,054 or European Patent No. 839886 A2) in view of Brown et al. ('978) and further in view of Deeb et al. ('882).

Regarding claims 2 and 4, Shirai et al. disclose a sheet for protecting paint films of automobiles which comprises a support comprising a thermoplastic polymer film and a pressure-sensitive adhesive layer (boxed regions of either disclosure).

Shirai et al. fail to disclose the support comprising a thermoplastic polymer film laminated on one or both surfaces of a non-woven fabric, wherein the non-woven fabric has a basis weight of 5 to 100 g/m<sup>2</sup>.

However, Brown et al. ('978) teach a protective cover for automobiles with superior impact resistance comprising a non-woven fabric and a thermoplastic film, wherein the non-woven fabric has a basis weight within applicants' claimed range (col. 1, lines 40 – 54; col. 12, lines 12 – 25; and Example 2).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Shirai et al. to include a support comprising a polymer film laminated on one or both surfaces of a non-woven fabric within applicants' claimed basis weight range as taught by Brown et al. in order to produce a protective cover for automobiles with superior impact resistance.

Neither Shirai et al. nor Brown et al. disclose the thermoplastic film being located between the pressure-sensitive adhesive layer and the non-woven fabric.

However, Deeb et al. teach an adhesive comprising a woven fabric, a thermoplastic film and a pressure-sensitive adhesive, where the polymer film is imposed between the fabric and the pressure-sensitive adhesive in order to prevent the adhesive from striking through the backing of the tape, penetrating the fabric and being contaminated with moisture (col. 3, lines 11 – 25 and col. 7, lines 34 – 47).

It would therefore have been obvious to one of ordinary skill in the art at the time of the applicant's invention to modify the device of Shirai et al. in view of Brown et al. to place the polymer film between the pressure-sensitive adhesive layer and the non-woven fabric layer as taught by Deeb et al. in order to prevent the adhesive from striking through the backing of the tape, penetrating the fabric and being contaminated with moisture.

Regarding claim 3, Brown et al. teach using thermoplastic films having a thickness within applicants' claimed range in order to produce protective sheets that are lightweight, waterproof and impact resistant (col. 1, lines 5 – 37; col. 8, lines 56 – 61 and Example 2).

### ***Response to Arguments***

10. Applicant's arguments with respect to claims 1 - 4 have been considered but are moot in view of the new ground(s) of rejection.



**Conclusion**

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Kevin M Bernatz whose telephone number is (703) 308-1737. The examiner can normally be reached on M-F, 9:00 AM - 6:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Paul Thibodeau can be reached on (703) 308-2367. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 305-6078 for regular communications and (703) 305-3599 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0651.



KMB  
June 15, 2001



Paul Thibodeau  
Supervisory Patent Examiner  
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